

Appl. No. 10/623,899
Amdt. dated December 21, 2005
Reply to Office Action of September 21, 2005

PATENT

REMARKS/ARGUMENTS

Claims 1-20 remain pending in the application, and Applicant respectfully requests reconsideration and allowance of the claims.

Discussion of Claim Rejections Under Obviousness Type Double Patenting

Claim 17 was rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claim 12 of U.S. Patent No. 6,595,416 to Newsome et al. (hereinafter Newsome). Applicant respectfully traverses the rejection and requests reconsideration and withdrawal of the rejection.

Claim 17 recites a method of adding a plurality of transaction values to a plurality of fare cards. The method includes "communicating with the transit station controller for authorizing a transaction value of the plurality of transaction values." Claim 12 from Newsome does not describe a plurality of transaction values, and does not describe authorizing a transaction value from a plurality of transaction values.

Claim 17 is not generic to claim 12 from Newsome, because claim 1 from the application includes features not recited in Newsome claim 12. Thus, claim 17 from the present application and claim 12 from Newsome cannot be classified as genus and species, as argued by the Examiner.

The Examiner provides no suggestion or motivation to modify the invention claimed in claim 12 of Newsome in a manner that would provide claim 17 of the present application. For example, there is no suggestion or motivation to modify claim 12 of Newsome in a manner that would provide for authorizing a transaction value from a plurality of transaction values. Therefore, Applicant believes that the Examiner fails to establish a *prima facie* case of obviousness in light of claim 12 from Newsome. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 17 under the doctrine of obviousness type double patenting.

Discussion of Rejections Under 35 USC §103(a)

Claims 1-6 and 12-15 were rejected under 35 USC §103(a) as allegedly unpatentable over Japanese Publication JP 09-305806 to Kiribuchi (hereinafter Kiribuchi) in

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view of U.S. Patent No. 5,754,654 to Hiroya et al. (hereinafter Hiroya). Claims 17-19 were rejected as allegedly unpatentable over Kiribuchi in view of U.S. Patent No. 5,832,090 to Raspotnik (hereinafter Raspotnik). Claims 7, 8, and 16 were rejected as allegedly unpatentable over Kiribuchi in view of Hiroya, and further in view of U.S. Patent No. 5,255,182 to Adams (hereinafter Adams). The Examiner contends that the combination of references describes the claimed inventions.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

The combination of Kiribuchi and Hiroya fails to teach or suggest all limitations of claim 1. The Examiner concedes that Kiribuchi fails to teach or suggest a means for storing a history of the at least one cashless transaction. However, the Examiner contends that Hiroya teaches of an electronic ticket system that utilizes ticket cards and a card reader/writer and is capable of storing transaction history.

None of the cited references teaches or suggests a fare card reader for reading and *writing* to the fare cards. Kiribuchi describes a manner of paying for an additional (excess) fare without having to add additional funds to a prepaid card. *Kiribuchi*, paragraph 11 and 12, ("...it is not necessary to pay the predetermined amount of money before like a prepaid card"). Kiribuchi is concerned with the ability to pay for an excess fare without having to have sufficient funds in a prepaid card, because the prepaid card can be lost or because the amount of money deposited onto a prepaid card creates a "user's pocketbook burden."

Kiribuchi fails to disclose an embodiment that writes to the fare card. Indeed, Kiribuchi is focused on *not* having to add value to a prepaid card, because such a value increases a "user's pocketbook burden."

In Kiribuchi, a patron inserts a ticket or fare card into a ticket input port and a main control section verifies that adequate funds are available and issues a settlement of accounts

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ticket to the user. *See Kiribuchi*, paragraph 23-32. A separate ticket from the initial, inserted ticket is printed to show that additional funds have been paid using a credit card. *Id.* at paragraph 32 (...this settlement-of-accounts ticket printing section 28 publishes from said settlement-of-accounts ticket issue opening 12 in it.”).

Claim 1 includes the ticket or fare card read by the fare card reader is the same ticket or fare card *written to* by the fare card reader. *Kiribuchi* does not teach or suggest every limitation of claim 1.

Hiroya discloses an electronic vending and refunding device. The invention described in Hiroya performs only three operations, namely, purchasing a ticket, confirming the content of the ticket, and refunding a ticket. *See Hiryoa*, Col. 6, ll 57-61. Hiroya does not teach or suggest a method for adding value to a preexisting ticket or fare card. Thus, there is no motivation to modify *Kiribuchi* in the manner suggested by the Examiner. Indeed, *Kiribuchi* is concerned with not having to add additional value to a prepaid card. Thus, there can be no proper motivation to enable *Kiribuchi* to write to fare cards, because such modification would be contrary to the very purpose of *Kiribuchi*. Thus, *Kiribuchi* does not suggest that is desirable to write value to the prepaid card, and quite to the contrary states that adding value to a prepaid ticket creates a user's pocketbook burden.

Therefore, Applicant respectfully requests reconsideration and allowance of claim 1. Claim 12 includes a similar feature of “writing to a magnetic strip fare card of the plurality of fare cards” Thus, Claim 12 is believed to be allowable for the same reasons provided with respect to claim 1.

Claims 2-11 and 13-16 depend from one of claims 1 or 12 and are believed to be allowable at least for the reasons that the claims depend from an allowable base claim. The Examiner does not allege that any of the other references cited in combination with *Kiribuchi* and Hiroya describe or otherwise suggest “writing to the fare card.” Applicant respectfully requests reconsideration and allowance of claims 2-11 and 13-16.

Claims 17 was rejected as allegedly unpatentable over *Kiribuchi* in view of *Raspotnik*. Claim 17 includes “writing the authorized transaction value to the fare card utilizing the one of a magnetic stripe card reader and the contactless card reader.”

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As described earlier, Kiribuchi fails to describe writing to a fare card, and teaches away from having the ability to write to a fare card. Raspotnik describes a stored value system using a host computer and a reader/writer to check and update information stored in the memory of the a radio frequency transponder. *See Raspotnik*, Col. 2, ll 26-33.

As described earlier, Kiribuchi states that it is undesirable to add value to prepaid cards because such value represents a "user's pocketbook burden." Raspotnik fails to suggest a motivation for modifying Kiribuchi in a manner that would overcome the undesirability of adding value to prepaid cards explicitly stated in Kiribuchi. Thus, there is no motivation to modify or otherwise combine the teachings of Kiribuchi with Raspotnik in the manner suggested by the Examiner.

Applicant respectfully request reconsideration and allowance of claim 17 because there is no motivation to modify Kiribuchi with Raspotnik in such a manner that would overcome the stated desire in Kiribuchi to avoid adding values to prepaid cards.

Claims 18-20 depend from claim 17 and are believed to be allowable at least for the reason that they depend from an allowable base claim.

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Discussion of Objections to Claims

Applicant thanks the Examiner for indicating allowable subject matter. Applicant has not amended claims 9 and 20 at this time to rewrite them to independent form including all of the limitations of the base claim and intervening claims. Applicant believes that the claims are in condition for allowance as depending from an allowable base claim. Applicant reserves the right to rewrite the claims to independent form in future correspondence.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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